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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/611,476 | 07/01/2003 | Robert E. Wycoff | PWYC0002/MRK | 3301 |

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| EXAMINER |
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COLAN, GIOVANNA B

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| ART UNIT | PAPER NUMBER |
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2162

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/611,476 | WYCOFF, ROBERT E. | |
| | Examiner | Art Unit | |
| | Giovanna Colan | 2162 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/01/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is issued in response to applicant filed application on 07/01/2003.
2. Claims 1 – 21 are pending.
3. The information disclosure statement (IDS) submitted on 07/01/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 12, and 15 – 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Buck et al. (Buck hereinafter) (US Patent No. 6,078,866, published: June 20, 2000).

Regarding Claim 12, Buck discloses a network-based message board system, said network-based message board system comprising a set of computer instructions

for: displaying a hypertext link on a predetermined line number (Fig. 4A, items 5a, URL#1, URL#2, etc, Col. 6, lines 23 – 28, Buck) within a fixed number of lines of a message board display (Col. 6, lines 24 – 26, Buck¹).

Regarding Claim 15, Buck discloses a method for embedding a hypertext link in an Internet message board display, said method comprising:

displaying on a predetermined set of particular display line positions within a fixed number of display line positions on a particular Internet message board a plurality of offer displays (Fig. 2B, Col. 6 and 7, lines 24 – 26 and 4 – 5, Buck).

Regarding Claim 16, Buck discloses a method wherein each particular display line position in the predetermined set of particular display line positions comprises a single offer display (Fig. 4A, item 5a, URL#1, Col. 6, lines 27 – 28, Buck).

¹ Examiner interprets the range between highest to lowest to be the fixed number of lines.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buck et al. (Buck hereinafter) (US Patent No. 6,078,866, filed: September 14, 1998) in view of L. Vigil et al. (Vigil hereinafter) (US Patent Pub. Application No. 2001/0034654 A1, filed: May 10, 2001).

Regarding Claim 1, Buck discloses a network-based message board system (Col. 3 and 4, lines 66 – 67 and 1 – 4, Buck), said system comprising:

a listing server connected to a network accessible by a plurality of users (Col. 4, lines 1 – 2, Listing server, Buck);

a message board site listings database accessible by the listing server, said site listings database comprising a plurality of site listings (Col. 4, lines 2 – 3, listing database, Buck), wherein each site listing comprises an embedded advertising link offer

Art Unit: 2162

identifier (Col. 4, lines 6 – 8, denominated value to be paid, Buck), and a Web site address (Col. 4, lines 5 – 6, network address, Buck);

Buck further discloses advertising offers displayed to customers (Col. 8, lines 58 – 61, Buck). However, Buck is silent with respect to an embedded advertising link offer database. On the other hand, Vigil discloses an embedded advertising link offer database accessible by the listing server (Fig. 1, item 200, Page 5, [0050], lines 1 – 2, Vigil), said embedded advertising link offer database comprising a plurality of embedded advertising link offers (Page 4, [0033], lines 4 – 9, Vigil), wherein each embedded advertising link offer comprises an embedded advertising link offer identifier (Fig. 2, item 211, Page 6, [0056], lines 6 – 7, ad ID, Vigil), a corresponding message board identifier (Fig. 2, item 213, Page 6, [0056], lines 6 – 7, company ID, Vigil), and an identifier of a particular display position within a fixed number of displayable positions on a message board that corresponds to said message board identifier (Fig. 2, item 217, Page 6, [0058], lines 8 – 15, Entrant Limit, Vigil²). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Vigil to the system and method of Buck. Skilled artisan would have been motivated to do so, as suggested by Vigil, in order to present an effective system for presenting advertisements to consumers (Page 1, [0005], lines 1 – 4, Vigil) and storing a link to the advertiser's e-commerce site (Page 1, [0006], lines 14 – 15, Vigil).

² Examiner interprets the Entrant Limit (included on Vigil's disclosure) as an identifier of a particular display position. According to Vigil, the entrant limit field would determine a display position, such as, determining the date, time, or after how many viewer entries to conduct drawings (Examiner also

Regarding Claim 2, the combination of Buck in view of Vigil discloses a system, said system further comprising:

a message board display program means, said message board display program means comprising executable program instructions for displaying a plurality of messages corresponding to a particular message board (Fig. 4, item 435 and 445, Page 9, [0086], lines 3 – 7, Vigil); and

said message board display program means further comprising executable program instructions for displaying each site listing of a plurality of site listings corresponding to the particular message board (Col. 6, lines 36 – 41, Buck) wherein each site listing is displayed on the particular display position corresponding to the particular embedded advertising link offer corresponding to the particular site listing (Col. 6, lines 38 – 40, Buck³).

Regarding Claim 3, the combination of Buck in view of Vigil discloses a system, said system further comprising:

an account interface to the network wherein said account interface is accessible by a plurality of subscribers (Fig. 2A, items 21 and 22, Col. 6, lines 48 – 51, Buck), and wherein said account interface comprising a set of program instructions for receiving information input by respective subscribers corresponding to a particular site listing (Fig. 2A, items 29, 27, 25, and 26, Col. 6, lines 62 – 67, Buck).

interprets that conducting the drawings would have to involve displaying drawing prizes and results to customers and/viewers).

Regarding Claim 4, the combination of Buck in view of Vigil discloses a system, wherein each embedded advertising link offer in the embedded advertising link offer database further comprises a fixed denominated value (Fig. 2, item 211, Page 6, [0056], lines 6 – 7, ad ID, Vigil).

Regarding Claim 5, the combination of Buck in view of Vigil discloses a system, wherein each site listing in the message board site listings database further comprises a denominated value (Col. 4, lines 6 – 8, denominated value to be paid, Buck; and, Fig. 2, item 211, Page 6, [0056], lines 6 – 7, ad ID, Vigil).

Regarding Claim 6, the combination of Buck in view of Vigil discloses a system, wherein the denominated value comprises a subscriber-determined bid amount input by a particular subscriber (Col. 8, lines 45 – 47, credit points, Buck).

Regarding Claim 7, the combination of Buck in view of Vigil discloses a system, wherein said bid amount may be adjusted by the particular subscriber during a defined adjustment period (Col. 9, lines 2 – 13, Buck).

³ Examiner interprets the feature of displaying listings from the highest to the lowest and displaying listings by categories and subcategories (disclosed in Buck's invention) as a system for displaying site listings on a particular display position.

Regarding Claim 8, the combination of Buck in view of Vigil discloses a system, wherein said account interface further comprises means for allowing a subscriber to enter a particular bid amount for a particular site listing (Col. 8, lines 45 – 47, Buck).

Regarding Claim 9, the combination of Buck in view of Vigil discloses a system, wherein said account interface provides means for each subscriber to search and view site listings previously entered by the particular subscriber (Col. 8, lines 14 – 18, reviewed at a later date, Buck), wherein said account interface provides means for displaying said site listings for the particular subscriber ranked in comparison to denominated values of other site listings entered by other subscribers (Col. 6, lines 38 – 41, Buck⁴).

Regarding Claim 10, the combination of Buck in view of Vigil discloses a system, wherein said account interface further provides means for each subscriber to enter a new bid amount in order to change the ranking of said subscriber's site listing relative to those of the other subscribers (Col. 8, lines 23 – 26 and 31 – 32, Buck⁵).

Regarding Claim 11, the combination of Buck in view of Vigil discloses a system, wherein said account interface further comprising:

⁴ According to Buck's disclosure, the listings will be displayed to users according to different categories and subcategories, including denominated values from highest to lowest (Col. 6, lines 38 – 41, Buck). Examiner interprets this feature as a system for displaying site listings for the particular subscriber ranked in comparison to denominated values.

a set of program instructions for maintaining for each particular subscriber a set of information for a plurality of embedded advertising link offers (Col. 6, lines 59 – 67, listing management program “URL POSITION MANAGERS”, Buck).

8. Claim 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buck et al. (Buck hereinafter) (US Patent No. 6,078,866, filed: September 14, 1998) in view of Soulanille (Soulanille hereinafter) (US Patent No. 6,978,263 B2, filed: June 1, 2001).

Regarding Claim 13, Buck discloses a network-based message board system, said network-based message board system further comprising a set of computer instructions for:

updating the message board display with a new message (Col. 7, lines 10 – 13, Buck); and

However, Buck is silent with respect to preserving the hypertext link position at the predetermined line number of the message board display. On the other hand, Soulanille discloses this limitation (Col. 21, lines 48 – 50 and 56 – 60, Soulanille). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Soulanille to system and method of Buck. Skilled artisan would have been motivated to do so, as suggested by Soulanille (Col. 4, lines 10

⁵ Examiner interprets: subscribers entering new bid amount in order to change the ranking of the

– 13, Soulanille), to provide an improved method for selecting and ordering search results listings that can maximize revenue for the search engine operator as well improving click through rates for web site promoters.

Regarding Claim 14, the combination of Buck in view of Soulanille discloses a network-based message board system, said network-based message board system comprising a set of computer instructions for:

preserving a position of an advertising link at a fixed display position within a message board display (Col. 21, lines 48 – 50 and 56 – 60, Soulanille).

9. Claim 17 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buck et al. (Buck hereinafter) (US Patent No. 6,078,866, filed: September 14, 1998) in view of Narin et al. (Narin hereinafter) (US Patent Pub. App. No. 2002/0046045 A1, filed: June 28, 2001).

Regarding Claim 17, Buck discloses all limitations as disclose above, including a method wherein each particular display line position of the predetermined set of particular display line positions is dedicated to displaying offers (Fig. 4A, item 5a, URL#1, Col. 6, lines 27 – 28, Buck). However, Buck is silent with respect to sell displayable web space. On the other hand, Narin discloses selling displayable space

subscribers' site listing, as the adjustment period of the rankings (disclosed in Buck's invention, Col. 8,

Art Unit: 2162

(Page 5, [0040], lines 26 – 31, Narin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the Narin's teachings with respect to displayable space to the system and method of Buck. Skilled artisan would have been motivated to do so, as suggested by Narin (Page 1, [0008], lines 1 – 3, Narin), in order to provide users with an infrastructure for shopping with a user application, such as content-rendering application.

Regarding Claim 18, the combination of Buck in view of Narin discloses a method wherein each subscriber display comprises a hypertext link (Fig. 4B, items 15a, Col. 6, lines 40 – 41, hyperlinks, Buck).

Regarding Claim 19, the combination of Buck in view of Narin discloses a method wherein the subscriber has paid a predetermined fee for a predetermined period of time for displaying the subscriber display (Col. 4, lines 54 – 56, subscription service on a periodic basis, Buck).

Regarding Claim 20, the combination of Buck in view of Narin discloses a method wherein the subscriber has paid a bid for a particular period of time for displaying the subscriber display (Col. 7 and 8, lines 67 and 1 – 2; respect, Buck).

Regarding Claim 21, the combination of Buck in view of Narin discloses a method wherein the particular subscriber display may be repositioned among the predetermined set of particular display line positions within the fixed number of display line positions (Col. 7, lines 43 – 48, Buck⁶).

⁶ Examiner interprets improving the listings' position (taught in Buck disclosure) as a method to reposition a subscriber display.

Prior Art Made Of Record

1. Buck et al. (US Patent No. 6,078,866, filed: September 14, 1998) discloses an internet site searching searching and listing service based on monetary ranking of site listings.
2. L. Vigil et al. (US Patent Pub. Application No. 2001/0034654 A1, filed: May 10, 2001) discloses an interactive internet advertising and e-commerce method and system.
3. Soulanille (US Patent No. 6,978,263 B2, filed: June 1, 2001) discloses a system and method for influencing a position on a search result list generated by a computer network search engine.
4. Narin et al. (US Patent Pub. App. No. 2002/0046045 A1, filed: June 28, 2001) discloses an architecture for electronic shopping service integratable with a software application.
5. Davis et al. (US Patent No. 6,983,272 B2; and US Patent No. 6,269,361 B1) discloses a system and method for influencing a position on a search result list generated by a computer network search engine.
6. Colace et. al. (US Patent No. 6,826,572 B2) discloses a system and method allowing advertisers to manage search listings in a pay for placement search system using grouping.
7. Conwell et al. (US Patent No. 6,970,886 B1) discloses consumer driven methods for associating content identifiers with related web addresses.


Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna Colan whose telephone number is (571) 272-2752. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Giovanna Colan
Examiner
Art Unit 2162
February 16, 2006


Sana Al-Hashmi